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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,053	01/08/2001	Christophe Bertez	S.5229 US - OP/MM	6760
466	7590	04/07/2004	EXAMINER	
YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			JOHNSON, JONATHAN J	
			ART UNIT	PAPER NUMBER

1725

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/755,053

Applicant(s)

BERTEZ ET AL. 

Examiner

Jonathan Johnson

Art Unit

1725

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

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Continuation of 5. does NOT place the application in condition for allowance because: Applicant argues the combination of Nielsen in view of Rolf et al. is based on hindsight. The examiner disagrees. Applicant is reminded that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant next argues that Nielsen teaches only pure gases can be used for cutting ordinary steel (i.e., oxygen) and stainless steel (i.e., nitrogen) when using a multiple focus lens. The examiner believes that applicant has mischaracterized the teachings of Nielsen. While Nielsen does suggest the use of a pure gas for cutting ordinary steel and stainless steel, Nielsen explains that the "gas used depends on the material to be cut" and that the examples provided were merely "typical" for the material (see Nielsen col. 2, ll. 49-56).

Applicant next argues that there is no motivation to combine because the references deal with alternative technologies as Nielsen teaches using a multiple focusing lens while Rolf et al. teach the use of a single focus lens. The examiner disagrees. To establish a prima facie case of obviousness, three basic criteria must be met: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. In *re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicant does not appear to argue the motivation to combine because he has not attacked the suggestion to combine the two references. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Instead, applicant argues that Nielsen and Rolf et al. are nonanalogous art. The examiner would like to point out that it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, it is the examiner's position that the references satisfies both prongs. First, with respect to the field of endeavor, Nielsen is directed to laser cutting a stainless steel workpiece using a lens and cutting gas (see Nielsen, col. 2, ll. 49-56) to reduce slag (see Nielsen, col. 2, ll. 1-2) while maintaining a fast cutting speed (see Nielsen, col. 3, ll. 40-47). Similarly, Rolf et al. is directed to laser cutting a stainless steel workpiece using a lens and cutting gas to maintain low burring and a fast cutting speed (see Rolf et al., pg. 2, ll. 9-30). Second, with respect to the pertinency of the particular problem, it is the examiner's position that both references deal with laser cutting a stainless steel workpiece using a laser and a cutting gas (see Nielsen, col. 3, ll. 40-47 and Rolf et al., pg. 2, ll. 9-30). While it is true that Nielsen uses a multi-focal lens and Rolf et al. use a single focal lens, it is the examiner's position that this is a distinction without a real difference. Nielsen uses a multi-focal lens instead of a single focal lens because the multi-focal lens ensures that the focal point of the beam can be positioned on the surface to be cut (see Nielsen col. 1, l. 60 through col. 2, l. 5). That is, Nielsen's invention deals with the accurate control of the laser beam focal point. Rolf et al., on the other hand, is completely silent with regard to the accurate control of the laser beam focal point. In fact, the examiner would like to note that Rolf et al. is completely silent with regard to the type of focusing lens and its operation. Rolf et al. is concerned not with the accurate control of the laser beam focal point but with lowering the cost of a laser cutting operation by using a nitrogen/oxygen mixture as a cutting gas instead of a pure nitrogen gas (Rolf et al. pages 2 and 3). Rolf et al. explain that an acceptable amount of oxidation occurs when using a nitrogen/oxygen gas composition in a laser cutting process (Rolf et al. page 2). Therefore, as stated in the previous office action, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the gas of Nielsen to utilize the gas of Rolf et al. in order to increase the laser cutting speed (see previous Office Action).

The submission of objective evidence of patentability does not mandate a conclusion of patentability in and of itself. In *re Chupp* 816 F.2d 643, 2 USPQ2d 1437 (Fed. Cir. 1987). Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of a prima facie case was reached, not against the conclusion itself. In *re Eli Lilly*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990). In the instant case, the affidavit by Nielsen merely states that he never considered using mixed gases in his multi-focal lens but that he was aware of using mixed gases in a single focal lens. Nielsen, however, does not explain the reasons as to why he never considered using mixed gases. That is, Nielsen does not give any reasons as to why an assist gas for a single focal lens is different than an assist gas for a multi-focal lens.

With respect to the Matile affidavit, it is argued that there is a "synergistic effect." Applicant is reminded that mere conclusion of unexpected results is not enough to establish unexpected results. The evidence relied upon should establish "that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance." *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992).

In the instant case, it is the examiner's position that although the record establishes evidence of secondary considerations which are indicia of nonobviousness, the record also establishes such a strong case of obviousness that the objective evidence of nonobviousness is not sufficient to outweigh the evidence of obviousness. *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 769, 9 USPQ2d 1417, 1427 (Fed. Cir. 1988), cert. denied, 493 U.S. 814 (1989); *Richardson-Vicks, Inc. v. The Upjohn Co.*, 122 F.3d 1476, 1484, 44 USPQ2d 1181, 1187 (Fed. Cir. 1997). The rejection is maintained despite applicant's traversal.